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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,147	06/30/2000	Jay S. Walker	99-110	2957
22927	7590	04/15/2004	EXAMINER CARLSON, JEFFREY D	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			ART UNIT PAPER NUMBER	

622

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,147

Applicant(s)

WALKER ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 and 57-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 and 57-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

This action is responsive to the paper(s) filed 1/20/04.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 67 is directed to non-statutory subject matter because the claims are not within the technological arts. See below.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

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Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

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that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claim 67 does not set forth any computer-based structure or steps requiring a computer. The claimed controller is not taken to necessarily require or set forth a computer. If applicant were to set forth that the compensation machine provides the compensation, then this is believed to set forth sufficient "technology."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 10-27, 29-41, 43, 49-54, 57-70, are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious

over Kolls (US6615183). Kolls teaches systems and methods for providing ecommerce and marketing functionalities to various POS and vending/compensation machines. Applicant's claim language of a "player" is taken to require nothing more than a "user." The adjective "player" merely describes a user and neither imparts any limitation regarding the method steps carried out by such a person, nor limits the systems/apparatus used by such person, as currently set forth by applicant. Applicant should set forth positive method steps or positive system/apparatus features in order to give sufficient meaning to the term "player." Applicant should define features of method steps, systems and apparatuses, not people. Kolls teaches that the user is identified by way of identity keys and smart cards, biometrics, barcode reader, keypad, touch screen, etc [7:55-58, 12:34-37]. The user is shown ads on the machine's screen and the user can respond to the advertising [15:1-5]. User verification can be done using local or remote databases [22:17-24]. Identified user's can be compensated with special pricing or promotional rewards [26:59+]; the machine may be programmed to compensate the user by changing its price structure based on the identified customer. Customer accounts may include identification, purchasing history and other customer information [27:39-45]. The displayed advertising may be targeted to the user based on the user's profile and presumably pre-defined marketing desires [33:38-50]. The user may respond to the ads and request that more information be given, a printout created, the user taken to a web site, or an audio interactive advertisement presented [35:35-45, 41:33-35]. This ability to receive user-responses from displayed ads is taken to inherently provide prompting/questioning the user if they desire more

information/services regarding the targeted products. This prompting/questioning is taken to be a survey for feedback; the machine surveys user's for product interest/feedback. Providing such additional information is taken to be compensation for the survey response. Further, Kolls teaches that users may respond to ads and in return may receive a coupon printout [41:24-29]. This is also taken to be compensation having a monetary value. Kolls also teaches user-response to an ad via touch screen [42:7-14]. Kolls further teaches that a touch-screen survey may be given to a user. Upon completion, the survey data is stored or sent to a central host and the user is thanked for participation [47:50+, 48:1-35]. Such thanks can be taken to be compensation. Further however, Official Notice is taken that it is well known to compensate users for completing surveys with such items as discounts, coupons, cash, credits, etc. It would have been obvious to one of ordinary skill at the time of the invention to have compensated the survey participants of Kolls so as to encourage higher participation rates.

Regarding claim 4, any questions that are displayed to the user are taken to be appropriate for the user. The questions are presented when requested. The user who participates in a survey is taken to be doing so during a period without interruption.

Regarding claim 15, 16, Kolls teaches to store the ad response results for statistical purposes; saved survey data includes warehousing data and making data available to others [34:26-32, 48:31-36]. "Others" is taken to include marketers interested in such data.



Regarding claim 21, Kolls teaches that user-input can be provided by way of voice recognition [12:34-38].

Regarding claim 68, the machine identifying a user inserting a coin is taken to accomplish determining a time the user is losing. The user is trading the inputted money for something in return which has less value (i.e. less the profit made by the vending entity); in this manner the user is losing.

Regarding claim 69, as stated above, the type of user (player, player with losing gambling history) does not impart any limitations to the steps carried out or to the system/apparatus used by such a person.

Regarding claim 70, the value earned as compensation to the player can be viewed as compensation for anything – including a gambling loss. The claim does not require the system/apparatus or method steps to determine or define any such gambling loss.

Claims 3, 6-9, 28, 42, 44-48, 69, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls.

Regarding claim 3, Kolls teaches that customer identification and customer accounts may include identification, purchasing history and other customer information [27:39-45]. It would have been obvious to one of ordinary skill at the time of the invention to have used any type of customer profile information in order to associate the response data with the customer profiles. Further, although Kolls does not teach gambling history, these differences are only found in the nonfunctional descriptive

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material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have associated any type of user data content. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 6-9, 28, 42, Official Notice is taken that it is well known to pre-define groups of customer segments for marketing purposes. It would have been obvious to one of ordinary skill at the time of the invention to have defined pools of users and identified users in such pools in order to carry out the targeted advertising/marketing features described by Kolls. Regarding claim 42, Kolls teaches user identification and association with user profiles. It would have been obvious to one of ordinary skill at the time of the invention to have populated created user accounts and associated profiles from user-submitted surveys so that user profiles are accurate.

Regarding claim 44-48, Kolls teaches that the compensation machines can be connected by way of LANs for operation [17:30-32]. Ad content can also be distributed by way of the LAN to each system 500 [fig 9b]. It would have been obvious to one of ordinary skill at the time of the invention to have delivered the survey questions via the LANs to the identified users as well. Regarding claim 45, any of the LAN-connected

systems which provide additional information, additional advertising or survey functions can be taken to be a fulfillment branch.

Regarding claims 69, 70, it would have been obvious to one of ordinary skill at the time of the invention for any type of person to have uses the machine, including people with winning gambling histories and losing gambling histories alike. Earning compensation can be inherently viewed as compensation for a gambling loss; the steps of compensation and losing do not require to have any particular relationship in these claims. Further, the "to offset a gambling loss" can be taken to be intended use and mere functional language.

Claims 1-54, 57-67 (alternatively) and 68-72, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls further in view of Jennings (US3750829).

Regarding claims 71, 72, Jennings teaches a vending machine that is further provided with a gambling/gaming apparatus in the form of slot reels. It would have been obvious to one of ordinary skill at the time of the invention to have added gambling/gaming functionality to the vending machine of Kolls in order to increase the attractiveness of the machine and to enable players/users to receive bonus compensation. The other claim limitations are addressed as above.

Regarding claims 68-70, it would have been obvious to one of ordinary skill at the time of the invention that the machine be used more than once by player(s) and/or that losing will occur. Any subsequent usage of the proposed combination would result in

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the “surveying” occurring after a player lost and after a reel was spun. Further, it would have been obvious to one of ordinary skill at the time of the invention to have provided the interactive session at any time, including after the slot machine functionality was played by the user as a matter of design choice. Any compensation by the machine can be taken to be “to offset a gambling loss” as treated above.

Regarding claim 74, compensating a winner having a matching slot machine symbols is taken to “retroactively activate” a payline in exchange for playing the gambling machine.

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls in view of Jennings and Paige (US5941772). Paige teaches a gambling slot machine whereby the “normal” symbols are replaced by advertising logos associated with a business. Paige also teaches the known use of video-based slots whereby the reels are digitally rendered during play. It would have been obvious to one of ordinary skill at the time of the invention to have provided such replaced logos in a digital version of slots with the device of Kolls/Jennings, so that the gaming operator can earn additional revenue from the advertising.

### ***Response to Arguments***

Applicant argues that a user is not a player. As stated above, applicant’s claim language of a “player” is taken to require nothing more than a “user.” The adjective “player” merely describes a user and neither imparts any limitation regarding the

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method steps carried out by such a person, nor limits the systems/apparatus used by such person, as currently set forth by applicant. Applicant should set forth positive method steps or positive system/apparatus features in order to give sufficient meaning to the term "player." Applicant should define features of method steps, systems and apparatuses, not people.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Cohen et al (US5373440) teaches slot machines with advertising logos on the reels as well as userID cards and prize winning.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc